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Frank Venegas JR.

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EXAMINER

SAWHNEY, HARGOBIND S

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/829,033	Applicant(s) VENEGAS, FRANK	
	Examiner HARGOBIND S. SAWHNEY	Art Unit 2885	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12 is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Request for Continued Examination RCE and the response to the office action, each filed on July 22, 2009 has been entered. Accordingly:

- Claim 1 has been amended; and a new claim 13 has been added.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,121,307 (Moore) in view of US Patent 4,718,185 (Conlin et al.).

Regarding claim 1, Moore discloses a lighted assembly 10 (Figure 4, column 2, line 18) further comprising:

- an elongated tubular body 11 having an open end 12, and a closed end 15 defining a cavity – enclosed by element 18 – (Figure 4);
- the open end 12 of the cavity receiving the stanchion 14 (Figures 1 and 4);
- a lighted assembly 10 (Figure 4, column 2, line 18) having a light source 17 (Figure 4, column 2, line 23) interconnected to a power source 22 (Figure 4, column 2, line 36);

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- the light source 17 secured relative to the tubular body 11, and making its light visible exteriorly of the interior cavity (Figures 1 and 4; and
- an elongated tubular body receiving the stanchion in its cavity; and
- the open end of the elongated tubular body proximate – interpreted with similar thinking as that included in the recitation- to the ground surface.

However, Moore does not specifically teach the stanchion having its open end proximate to the ground.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the lighted assembly of Moore by extending the length of the elongated tubular body, and accommodating entire stanchion with in itself, or making its open end contacting the ground, since such a modification would have involved a mere change in size of the component. A change in size is generally recognized as being within the level of ordinary skill in the art.

Further, as discussed above, Moor teaches the batteries positioned within the tubular body instead of them being positioned outside the tubular body as claimed by the applicant.

On the other hand, Conlin et al. discloses a lighting assembly (Figure 1) operationally coupled to a solar power generating system 12 and a storage battery 5 positioned out side the lighting assembly (Figures 1 and 2, column 3, lines 64--68; and column 4, lines 1-17).

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It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the lighted assembly of Moore by repositioning the batteries outside the lighting assembly for the benefits of cost effective maintenance and replacement.

In addition, it would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the lighted assembly of Moore by repositioning the batteries outside the lighting assembly rather than they being positioned inside the lighting assembly, since it has been held that rearranging parts of a prior art structure involves only routing skill in the art. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

Regarding Claim 2, Moore in view of Conlin et al. disclose a lighted assembly meeting the limitations in similar manner as that applied to the amended independent claim 1 discussed above.

Regarding claims 3-6, Moore in view of Conlin et al. discloses the lighting assembly additionally including:

- an electronic circuit (Moore, Figures 1, 3 and 4) managing and controlling power for the device; and
- the lighted assembly 10 further having a light source receptacle (not shown) receiving the lamp 17 (Moore, Figure 1);
- the lighted assembly 10 further comprising a plurality of photovoltaic devices 28 (Moore, Figure 4, column 2, line 50) supported by the elongated tubular body 11 (Moore, Figures 1 and 4); and
- the power source being a battery 22 (Moore, Figure 4, column 2, line 36).

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4. Claims 7, 8, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore (U.S. Patent No. 5,121,307) in view of US Patent 4,718,185 (Conlin et al.) as applied to claim 1 above, and further in view of U.S. Patent No. 6,204,477 (Lyons).

Regarding claims 7, 10 and 11, Moore in view of Conlin et al. discloses a lighted assembly including the light source secured relative to the tubular body, and making its light visible exteriorly of the interior cavity.

However, neither in combination nor Moore and Conlin et al. teaches the elongated tubular body displaying a message illuminated with light emitting diodes LEDs.

On the other hand, Lyons discloses an illuminated sign assembly 10 mounted on a post 16, and displaying a message 38 illuminated with light emitting diodes LEDs 18 (Figures 2 and 4, column 2, lines 34-44; and column 3, lines 16-25).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the lighted assembly of Moore in view of Conlin et al. by providing stenciled message sign on the post as taught by Lyons for the benefit and advantage of cost-effective display messages having high attention value.

Regarding claim 8, Moore in view of Conlin et al. discloses a lighted assembly including a message 38 as applied to claim 7 discussed above.

However, neither in combination nor Moore and Conlin et al. teaches the elongated tubular body displaying a message being stenciled letters or message.

a. The limitation “the message is stenciled letters or message” is the product-by-process limitation.

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to message including stenciled letters, since it has been held by the courts that patentability of a product does not depend on its method of production. If the product in the product-by-process claim is disclosed, or suggested, by the Prior Art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moore (U.S. Patent No. 5,121,307) in view of US Patent 4,718,185 (Conlin et al.) as applied to claim 1 above, and further in view of Japanese Pattern No. JP 08239812 A (Kageyama et al.).

Regarding claim 9, Moore in view of Conlin et al. discloses a lighted assembly including the light source secured relative to the tubular body, and making its light visible exteriorly of the interior cavity.

However, neither in combination nor Moore and Conlin et al. teaches the elongated tubular body displaying a message including at least one light dispersing window.

On the other hand, Kageyama et al. discloses an illuminated sign assembly (Figure 1) mounted on a post 1, and displaying a message 15 including more than one light-dispersing windows (Kageyama et al. Figure 1. English translated abstract).

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It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the lighted assembly of Moore in view of Conlin et al. by providing stenciled message sign on the post as taught by Kageyama et al. for the benefit and advantage of cost-effective display messages having high attention value.

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moore (U.S. Patent No. 5,121,307) in view of US Patent 4,718,185 (Conlin et al.) as applied to claim 1 above, and further in view of US Patent 6,120,165 (Shalvi).

Regarding claim 9, Moore in view of Conlin et al. discloses a lighted assembly including the light source secured relative to the tubular body, and making its light visible exteriorly of the interior cavity.

However, neither in combination nor Moore and Conlin et al. teaches the elongated tubular body including a proximity detector and control electronics.

On the other hand, Shalvi discloses a solar-powered lighting assembly mounted on an elongated body 10 comprising a proximity detector 14 operatively connected to control electronics capable of activating the light emitting elements included in the diffusing elements 15 and 16 (Figure 1, column 1, lines 41-67).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the lighted assembly of Moore in view of Conlin et al. by providing the proximity detector as taught by Shalvi for the benefits of alarming presence of an intruder.

Allowable Subject Matter

7. Claim 12 is allowed.

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The prior art of record, including Moore (U.S. Patent No. 5,121,307), fails to show or suggest the applicant's invention as claimed. Specifically, the prior art of record does not disclose proper motivation for combining:

- the body of the cover having a second cavity defined by the inner and outer surfaces and the thickness; and
- the second cavity encapsulating a photo-luminescent mixture.

The above-indicated combination, including a body of a cover having a second cavity encapsulating a photo-luminescent mixture, makes this invention unique.

Therefore, Claim 12 is allowed over prior art.

Response to Amendment

8. Applicant's arguments filed on July 22, 2009 with respect to the 35 U.S.C. 103(a) rejections of claims 1-11 have been fully considered but are moot in view of the new ground(s) of rejections necessitated by the amendment.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hargobind S Sawhney whose telephone number is 571 272 2380. The examiner can normally be reached on 8:30 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jong-Suk (James) Lee can be reached on 571 272 7044. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

7/26/2009

/Hargobind S. Sawhney/
Primary Examiner; Art Unit 2885